

**REMARKS**

Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 54, 56-59, 61, and 62 have been amended for reasons unrelated to patentability, including at least one of: to addressing an informality, to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification thereby not narrowing the scope of the claim, to detect infringement more easily, to enlarge the scope of infringement, to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.), to expedite the issuance of a claim of particular current licensing interest, to target the claim to a party currently interested in licensing certain embodiments, to enlarge the royalty base of the claim, to cover a particular product or person in the marketplace, and/or to target the claim to a particular industry.

Claims 52-62 are now pending in this application. Claims 52 and 59 are the independent claims.

**I. The Objection to Claims 54, 56, and 61**

Claims 54, 56, and 61 were objected to because of informalities. Claims 54, 56, and 61 have been amended to correct the informalities. Therefore, Applicants respectfully submit that any grounds for this objection have been removed, and respectfully request acknowledgment thereof.

**II. The Indefiniteness Rejection**

Claims 59-62 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. This rejection is respectfully traversed. Claim 59 has been broadened, and amended to correct a clerical error, thereby explicitly presenting one or more elements implicit in the claim as originally

written when viewed in light of the specification, and thereby not narrowing the scope of the claim. Each of claims 56-58, 61, and 62 has been broadened.

Thus, reconsideration and withdrawal of this rejection is respectfully requested.

### **III. The Antecedent Basis Rejection**

Claim 59 was rejected under 35 U.S.C. 112, second paragraph, as lacking sufficient antecedent basis for the limitation “said method” in lines 21-22 and “said instruction” in line 30. This rejection is respectfully traversed. Claim 59 has sufficient antecedent basis for the limitation “said method” in lines 21-22 and “said instruction” in line 30. Therefore, reconsideration of this rejection is respectfully requested.

### **IV. The Obviousness Rejection**

Claims 52-62 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Roy (U.S. Patent No. 6,321,331) in view of Logan (U.S. Patent No. 6,234,857). These rejections are respectfully traversed.

None of the cited references, either alone or in any combination, establish a *prima facie* case of obviousness. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.” See MPEP § 2143.

**A. Claim 52**

Independent claim 52 recites:

- “displaying a section of said program indicated by a user to be debugged”;
- “compiling said section of said program to be debugged in another section of memory”, and
- “jumping to said another section of said memory during execution of said program when an instruction indicated to be debugged is to be executed.”

Neither Roy nor Logan, alone or in combination, expressly or inherently teach or suggest:

- “displaying **a section** of said program **indicated by a user** to be debugged”;
- “**compiling** said section of said program to be debugged **in another section of memory**”; and
- “**jumping to said another section of said memory** during execution of said program when an instruction indicated to be debugged is to be executed”.

**1. Roy**

Roy allegedly recites “[a]s **the program is running on the ASIC 10**, the debugging computer 44 collects information from the first decoders and the history buffer. The information collected by the computer 44 is associated with **each line of code** being executed by the ASIC by **stepping through the copy of the code** which is stored in the computer 44.” See Col. 7, lines 45-50.

Roy’s “debugging computer” “stepping through” “**each line of code**” stored on the “debugging computer” does not expressly or inherently teach or suggest the claimed “displaying **a section** of said program **indicated by a user** to be debugged.”

Also, Roy's "debugging computer" "stepping through" **"each line of code"** stored on the "debugging computer" does not expressly or inherently teach or suggest the claimed **"compiling"** a user-indicated **"section"** of a "program".

Further, Roy's storing of a "copy of the code" on the "debugging computer" does not expressly or inherently teach or suggest the claimed **"compiled section"** of the program located in **"another section of memory."**

Since Roy does not expressly or inherently teach or suggest **"compiling"** any "section" of the "program" in **"another section of memory"**, Roy does not expressly or inherently teach or suggest **"jumping to said another section of said memory"**.

## 2. Logan

Logan does not overcome the deficiencies of Roy. Logan allegedly recites **"debugging an original program"** during a run-time execution of the program.... [U]pon interrupt of the execution ... [the debugger] ... takes control over the machine control system and displays a highlighted flowchart element on the display or monitor 24, which **flowchart block is the one being executed at the time of the interrupt** of the machine control." See Col. 3, lines 65-67; Col. 4, lines 2-7.

Logan's **debugger's displaying** of "a highlighted flowchart element" does not expressly or inherently teach or suggest the claimed **"displaying a section of said program indicated by a user to be debugged."**

Also, Logan's displaying "a highlighted flowchart element" does not expressly or inherently teach or suggest **"compiling"** a user-indicated section of a program **"in another section of memory."**

Further, Logan's "debugging an original program" does not expressly or inherently teach or suggest **"compiling"** a user-indicated "section" of a "program".

Since Logan does not expressly or inherently teach or suggest “compiling” any “section” of the “program” in “**another section of memory**”, Logan does not expressly or inherently teach or suggest “**jumping to said another section of said memory**”.

#### B. Claim 59

Independent claim 59 recites “another area of memory for storing **a compiled section of said program to be debugged ... a branch that causes execution of said program to jump** from said original compiled code **to said another section of said memory** during execution of said program when an instruction indicated to be debugged is to be executed.”

Similar to the explanation provided above for claim 52, neither Roy nor Logan, alone or in combination, expressly or inherently teach or suggest “another area of memory for storing **a compiled section of said program to be debugged ... a branch that causes execution of said program to jump** from said original compiled code **to said another section of said memory** during execution of said program when an instruction indicated to be debugged is to be executed.”

#### C. Summary

Moreover, there is no properly demonstrated motivation or suggestion to combine Roy with Logan, nor any indication that such a combination would be operative or fit for the intended purposes of Roy and Logan, nor any indication that such a combination would not change the principal of operation of Roy or Logan.

But even assuming, *arguendo*, that the cited references are combinable or modifiable, the cited references still do not expressly or inherently teach or suggest **every** limitation of the claims. Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

**CONCLUSION**

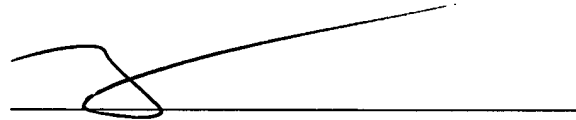
It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 732-321-3113 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC

Date: 10 March 04



Michael N. Haynes  
Registration No. 40,014

1341 Huntersfield Close  
Keswick, VA 22947  
Telephone: 434-972-9988  
Facsimile: 815-550-8850